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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,328	03/13/2001	William D. Budinger	156US	1796

7590

11/05/2003

Rodel Holdings, Inc.  
Suite 1300  
1105 North Market Street  
Wilmington, DE 19899

EXAMINER
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WILSON, LEE D

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 11/05/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

09/805,328

Applicant(s)

BUDINGER ET AL.

Examiner

LEE D WILSON

Art Unit

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-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 33-44 is/are pending in the application.
- 4a) Of the above claim(s) 41-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5&6. 6) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 33-40, drawn to an apparatus, classified in class 451, subclass 41.
- II. Claims 41-44, drawn to a method, classified in class 451, subclass 28.

The inventions are distinct, each from the other because:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus which does not require having discontinuities forming in a matrix.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Applicant response to the Restriction Election Requirement***

7. Applicant has already elected Group I, claims 33-40 without traverse in paper 13. This is acknowledged by the examiner.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published

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under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 (c) of this title before the invention thereof by the applicant for patent.

9. Claim 33 is rejected under 35 U.S.C. 102(e) as being anticipated by Bartlett (6428386).

Bartlett discloses a polishing pad having a first wear surface (162), a window portion (180 that has a diamond pane) that is greater or equal than a wear rate.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartlett (6428386).

- a. Bartlett is discussed above.
- b. Bartlett discloses the claimed invention except for a second wear rate 5% to 25% greater than the first wear rate. It would have been obvious to one having ordinary skill in the art

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at the time the invention was made to have used a range with a second wear rate 5% to 25% greater than the first wear rate, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the. *In re Aller*, 105 USPQ 233. (Note: the second is greater but the range is not disclosed.)

12. Claims 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartlett (6428386) in view of Roberts et al (6171181).

a. Bartlett is discussed above.

b. Bartlett discloses the claimed invention except for materials including a polymerized blend of two immiscible polymers; and solid matter.

c. Roberts et al disclose a polishing pad with a window using materials including a polymerized blend of two immiscible polymers; and solid matter; silica, titania, alumina, ceria, plastic which are used to compose polishing pad with windows.

d. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Bartlett device by providing materials including a polymerized blend of two immiscible polymers; and solid matter as taught by Roberts et al which are used to compose polishing pad with windows.

13. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartlett (6428386) in view of Adefris et al

a. Bartlett is discussed above.

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b. Bartlett discloses the claimed invention except for materials from a group consisting of silica, titania, alumina, ceria, and plastic.

c. Adefris et al disclose a polishing pad using and having materials including silica and plastic which are used in the composition of polishing pads.

d. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Bartlett device by providing materials including silica and plastic as taught by Adefris et al which are used in the composition of polishing pads.

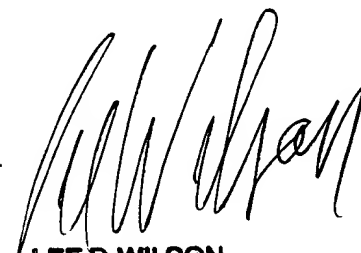
***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Birang et al and Tolles discloses a device.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Wilson whose telephone number is (703) 305-4094.

ldw

October 30, 2003



**LEE D. WILSON**  
**PRIMARY EXAMINER**